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**OFFICE OF PETITIONS**

In re Application of  
Tanabayashi et al.  
Application No. 09/786818  
Patent No. 7010306  
Attorney Docket No. 9682/82

:  
:DECISION DISMISSING PTA  
:RECONSIDERATION  
:  
:

This decision is in response to patentees' REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT PURSUANT to 37 CFR 1.705(d) TIMELY FILED ON MAY 5TH requesting that the Office adjust the PTA at the time of the issuance of the patent from a determination of 535 to a determination of 1087 days.

Patentees' letter regarding PTA is **DISMISSED**. The proper amount of PTA at the time of the issuance of the patent is 535 days as printed on the front page of the patent.

Patentees are given 30-days or one month whichever is longer to respond to this decision. No extensions of time are granted under 37 CFR 1.136.

Patentees' assert that the Office made two errors in the determination of the PTA. 1) The Office failed to provide any additional PTA for the Office's failure to issue the application within three years of the filing date. 2) The Office assessed too much PTA reduction under 37 CFR 1.704(c)(10). Patentees' assert that the Office should assess any additional PTA addition of 563 days<sup>1</sup> which is the amount of time from the three year anniversary date until the date of filing the RCE. Patentees further assert that the only delay under 37 CFR 1.704(c)(10) is the submission of the drawings.

Patentees' assertions are not persuasive. Patentees argument relating to 37 CFR 1.702(b) is not persuasive. Patentees are advised that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more

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<sup>1</sup>Patentees assert that the additional 563 days began on March 10, 2004 (day after 3-year anniversary date and ended on September 23, 2005, date of submission of RCE request.

than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). Because the PTA amount awarded under 37 CFR 1.704(a)(1) is greater than the delay under 37 CFR 1.702(b), applicants will receive no additional PTA time.

In addition, Patentees properly received a reduction of 46 and 25 days under 37 CFR 1.704(c)(10). Applicant submitted both an amendment under 37 CFR 312 as well as drawing submission on 12-27-05. The Office responded to the 312 amendment on January 20, 2006. The response did not address the submission of the drawings filed after the mail date of the notice of allowance. Accordingly, the reduction for the submission of the 312 amendment amounted to 25 days. The reduction for the drawings began on January 21, 2006<sup>2</sup> and amounted to 46 days.

After the mailing of this decision, the patented file will be forwarded to the file repository for proper storage of such patented file.

The Office has assessed the \$200.00 fee to deposit account 23-1925. No additional fees are required in deciding this request for reconsideration of the patent term adjustment determination.

Any questions concerning this decision should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.

*Kery A. Fries*

Kery A. Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

cc: PTA determination

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<sup>2</sup>t is noted that the drawing submission overlapped with the 312 amendment (both filed on 12/27/05) and the Office does not reduce the PTA for overlapping reduction periods.

Accordingly, the drawing submission reduction began on January 21, 2006 and ended on March 7, 2006, the date for issuance of the patent.

Day : Thursday

Date: 9/7/2006

Time: 13:48:22


**PALM INTRANET**
**PTA Calculations for Application: 09/786818**

|                          |            |                         |     |
|--------------------------|------------|-------------------------|-----|
| Application Filing Date: | 03/09/2001 | PTO Delay (PTO):        | 663 |
| Issue Date of Patent:    | 03/07/2006 | Three Years:            | 0   |
| Pre-Issue Petitions:     | 0          | Applicant Delay (APPL): | 128 |
| Post-Issue Petitions:    | 0          | Total PTA (days):       | 535 |
| PTO Delay Adjustment:    | 0          |                         |     |

**File Contents History**

| Number | Date       | Contents Description                            | PTO | APPL | START |
|--------|------------|---|-----|------|-------|
| 75.5   | 02/15/2006 | PTA 36 MONTHS                                   |     |      |       |
| 75     | 03/07/2006 | PATENT ISSUE DATE USED IN PTA CALCULATION       |     |      |       |
| 74     | 01/31/2006 | EXPORT TO FINAL DATA CAPTURE                    |     |      |       |
| 73     | 01/27/2006 | FINISHED INITIAL DATA CAPTURE                   |     |      |       |
| 72     | 01/30/2006 | DISPATCH TO FDC                                 |     |      |       |
| 71     | 01/20/2006 | MAIL RESPONSE TO 312 AMENDMENT (PTO-271)        |     |      |       |
| 70     | 01/19/2006 | RESPONSE TO AMENDMENT UNDER RULE 312            |     |      |       |
| 69     | 12/27/2005 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)  |     | 25   | 71    |
| 68     | 01/11/2006 | APPLICATION IS CONSIDERED READY FOR ISSUE       |     |      |       |
| 67     | 12/27/2005 | WORKFLOW - DRAWINGS FINISHED                    |     | 46   |       |
| 66     | 12/27/2005 | ISSUE FEE PAYMENT VERIFIED                      |     |      |       |
| 65     | 12/27/2005 | ISSUE FEE PAYMENT RECEIVED                      |     |      |       |
| 64     | 11/01/2005 | EXPORT TO INITIAL DATA CAPTURE                  |     |      |       |
| 63     | 10/27/2005 | MAIL NOTICE OF ALLOWANCE                        |     |      |       |
| 62     | 10/26/2005 | ISSUE REVISION COMPLETED                        |     |      |       |
| 61     | 10/26/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED |     |      |       |
| 60     | 10/26/2005 | NOTICE OF ALLOWABILITY                          |     |      |       |
| 59     | 09/23/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED     |     |      |       |
| 58     | 09/23/2005 | REFERENCE CAPTURE ON IDS                        |     |      |       |
| 57     | 09/23/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED    |     | 0    | 53    |
| 56     | 10/06/2005 | DATE FORWARDED TO EXAMINER                      |     |      |       |

|    |            |  |     |    |    |
|----|------------|--|-----|----|----|
| 55 | 09/23/2005 | AMENDMENT SUBMITTED/ENTERED WITH<br>FILING OF CPA/RCE      |     |    |    |
| 54 | 10/06/2005 | DATE FORWARDED TO EXAMINER                                 |     |    |    |
| 53 | 09/23/2005 | REQUEST FOR CONTINUED EXAMINATION<br>(RCE)                 |     | 57 | 40 |
| 52 | 10/06/2005 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS<br>ABANDONMENT IF CPA) |     |    |    |
| 51 | 09/23/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED                    |     |    |    |
| 45 | 09/23/2005 | WORKFLOW - REQUEST FOR RCE - BEGIN                         |     |    |    |
| 44 | 07/18/2005 | MAIL ADVISORY ACTION (PTOL - 303)                          |     |    |    |
| 43 | 07/14/2005 | ADVISORY ACTION (PTOL-303)                                 |     |    |    |
| 42 | 07/06/2005 | DATE FORWARDED TO EXAMINER                                 |     |    |    |
| 41 | 06/28/2005 | AMENDMENT AFTER FINAL REJECTION                            |     |    |    |
| 40 | 04/28/2005 | MAIL FINAL REJECTION (PTOL - 326)                          |     |    |    |
| 39 | 04/27/2005 | FINAL REJECTION  |     |    |    |
| 38 | 04/19/2005 | DATE FORWARDED TO EXAMINER                                 |     |    |    |
| 37 | 03/22/2005 | RESPONSE AFTER NON-FINAL ACTION                            |     |    |    |
| 36 | 01/04/2005 | MAIL NON-FINAL REJECTION                                   |     |    |    |
| 35 | 01/03/2005 | NON-FINAL REJECTION  |     |    |    |
| 34 | 01/03/2005 | IFW TSS PROCESSING BY TECH CENTER<br>COMPLETE              |     |    |    |
| 33 | 12/19/2004 | DATE FORWARDED TO EXAMINER                                 |     |    |    |
| 32 | 09/13/2004 | AMENDMENT SUBMITTED/ENTERED WITH<br>FILING OF CPA/RCE      |     |    |    |
| 31 | 12/19/2004 | DATE FORWARDED TO EXAMINER                                 |     |    |    |
| 30 | 09/13/2004 | REQUEST FOR CONTINUED EXAMINATION<br>(RCE)                 |     |    |    |
| 29 | 12/19/2004 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS<br>ABANDONMENT IF CPA) |     |    |    |
| 28 | 09/13/2004 | WORKFLOW INCOMING AMENDMENT IFW                            |     |    |    |
| 27 | 09/13/2004 | WORKFLOW - REQUEST FOR RCE - BEGIN                         |     |    |    |
| 26 | 06/16/2004 | MAIL FINAL REJECTION (PTOL - 326)                          |     |    |    |
| 25 | 06/14/2004 | FINAL REJECTION  |     |    |    |
| 24 | 06/09/2004 | DATE FORWARDED TO EXAMINER                                 |     |    |    |
| 23 | 06/01/2004 | RESPONSE AFTER NON-FINAL ACTION                            |     |    |    |
| 22 | 06/01/2004 | WORKFLOW INCOMING AMENDMENT IFW                            |     |    |    |
| 21 | 03/02/2004 | MAIL NON-FINAL REJECTION                                   | 663 |    | 3  |
| 20 | 02/23/2004 | NON-FINAL REJECTION  |     |    |    |

|    |            |   |  |  |
|----|------------|---|--|--|
| 19 | 01/02/2004 | INFORMATION DISCLOSURE STATEMENT (IDS)<br>FILED |  |  |
| 18 | 09/09/2003 | CASE DOCKETED TO EXAMINER IN GAU                |  |  |
| 17 | 09/03/2003 | CASE DOCKETED TO EXAMINER IN GAU                |  |  |
| 16 | 07/16/2003 | CASE DOCKETED TO EXAMINER IN GAU                |  |  |
| 15 | 02/20/2003 | CASE DOCKETED TO EXAMINER IN GAU                |  |  |
| 14 | 01/14/2003 | CASE DOCKETED TO EXAMINER IN GAU                |  |  |
| 13 | 05/03/2001 | PRELIMINARY AMENDMENT                           |  |  |
| 12 | 05/03/2001 | INFORMATION DISCLOSURE STATEMENT (IDS)<br>FILED |  |  |
| 11 | 06/20/2001 | CASE DOCKETED TO EXAMINER IN GAU                |  |  |
| 10 | 05/18/2001 | APPLICATION DISPATCHED FROM OIPE                |  |  |
| 9  | 05/11/2001 | IFW SCAN & PACR AUTO SECURITY REVIEW            |  |  |
| 8  | 04/30/2001 | CORRESPONDENCE ADDRESS CHANGE                   |  |  |
| 7  | 04/27/2001 | RELEASED TO OIPE                                |  |  |
| 6  | 04/27/2001 | NOTICE OF DO/EO ACCEPTANCE MAILED               |  |  |
| 5  | 04/26/2001 | 371 APPLICATION PREEXAMINATION<br>DOCKETING     |  |  |
| 4  | 03/29/2001 | 371 APPLICATION PREEXAMINATION<br>DOCKETING     |  |  |
| 3  | 03/09/2001 | RECEIPT OF 371 REQUEST                          |  |  |
| 2  | 03/29/2001 | CORRESPONDENCE ADDRESS CHANGE                   |  |  |
| 1  | 03/09/2001 | INITIAL EXAM TEAM NN                            |  |  |

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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